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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,631	04/22/2004	Frank J. Hodges	LEXANI.032C2	7298

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EXAMINER
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JOHNSTONE, ADRIENNE C

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/829,631

Applicant(s)

HODGES ET AL.

Examiner

Adrienne C. Johnstone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>012505</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>042204; 062304; 120104</u> | 6) <input type="checkbox"/> Other: _____   |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-18, drawn to a tire whose inboard tire wall has a bead and whose outboard wall has a bead, a wheel protector, and a flange seat, classified in class 152, subclass 523.
  - II. Claims 19-30, drawn to a tire whose outboard tire wall width is at least 3-1/2 inches and whose flange seat has a width of between about one-quarter and about on-half as large as the width of the outboard tire wall and is configured to receive a flange with an outboard face attached to a wheel mounted within the tire without obscuring the outboard face of the flange, classified in class 152, subclass 454.
  - III. Claims 31-42, drawn to a tire whose inboard tire wall has a bead and whose outboard tire wall has a flange seat and a bead, at least a portion of the outboard tire wall radially outward of the flange seat extending further in the outboard direction than any portion of the tire wall in the flange seat, the width of the flange seat being at least about 1-1/2 inches and at least about 1/2 inch greater than the width of the outboard bead, classified in class 152, subclass 544.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II-III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility such as a tire without the particular features of Inventions II and III, Invention II has separate utility such as a tire without the particular

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features of Inventions I and III, and Invention III has separate utility such as a tire without the particular features of Inventions I and II. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Paul Conover on January 26, 2005 a provisional election was made without traverse to prosecute the invention of Group III, claims 31-42. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

6. The disclosure is objected to because of the following informalities: applicants should update the status of the parent application in paragraph 0001 of the specification.

Appropriate correction is required.

One way to overcome this objection would be to rewrite paragraph 0001 as --

[0001] This application is a continuation of U.S. Application No. 10/266,040, filed October 7, 2002, now U.S. Patent 6,820,669, issued November 23, 2004, which is incorporated herein by reference.

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7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the flange seat width recited in claim 31 is not yet recited in the specification.

One way to overcome this objection would be to rewrite specification paragraph 0049 such that in line 12 before the period has been inserted -- and can be at least about 1-1/2 inches -- (not in original disclosure of parent application, but not new matter because original parent specification paragraph 0046 and original parent claims 8, 15, and 18 recite that the width of outer flange 66 on the rim may be about 1-1/2 inches or beyond (at least about 1-1/2 inches in the original parent claims) and original parent specification paragraph 0048 recites that the flange seat is preferably contoured to generally match the inboard face of the outer flange 66 of the rim).

***Claim Rejections - 35 USC § 112***

8. Claims 31-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

In claim 31 applicants now recite “an outboard tire wall with a flange seat and an outboard bead”, however in the original parent specification paragraph 0046 (and original specification paragraph 0049 in this application) the flange seat is defined as extending all the way to the inner diameter  $d_i$  of the outboard tire wall and therefore the flange seat *includes* the outboard bead. Also, in claim 31 applicants now recite that the width of the flange seat is “at least about 1/2 inches greater than the width of the outboard bead”, which is not supported by the original disclosure of the

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parent application (added for the first time in original claim 31 of this application). Finally, in claim 34 applicants now recite that the inboard and outboard tire walls are “approximately mirror images of each other”, which is not supported by the original disclosure of the parent application (added for the first time in original claims 3, 21, and 34 of this application).

9. Claims 31-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

To eliminate the new matter noted in paragraph 8 above and to clarify the definition of the terms “flange seat” and “bead” as set forth in the specification and drawings (see specification paragraphs 0047-51 and Figure 11), applicants should rewrite claim 31 as --

31. (currently amended) A tire for enhancing a simulated appearance of a large-diameter wheel mounted within a low-profile tire, the tire comprising:

an outboard tire wall with a wheel protector, a ledge, and a flange seat ~~[[and]]~~ including an outboard bead, an inboard tire wall with an inboard bead, and a tread therebetween;

the beads being comprised of indented rings formed on the inner radial edges of the respective inboard and outboard tire walls;

the wheel protector extending in the outboard direction further than any portion of the outboard tire wall in the flange seat;

the flange seat having an inner diameter, an outer diameter, and a width therebetween, the inner diameter being the inner diameter of the outboard tire wall and the outer diameter being the diameter of the ledge ~~[[and the outboard bead having an inner diameter, an outer diameter, and a width therebetween, wherein at least a portion of the outboard tire wall in a region positioned~~

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radially outwardly from the flange seat extends further in the outboard direction than any portion of the tire wall in the flange seat]]]; and

the width of the flange seat being at least about 1-1/2 inches[[, and at least about 1/2 inches greater than the width of the outboard bead]].

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To provide proper antecedent basis applicants should rewrite claim 32 as --

32. (currently amended) The tire of claim 31, wherein the respective inboard and outboard beads each have an inner diameter, an outer diameter, and a width therebetween, and the inboard bead and the outboard bead have substantially the same width.

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In claim 33 applicants recite that the flange seat is “substantially more rigid than the remainder of the outboard tire wall”, however this language is indefinite because a) the location of the boundary between the outboard tire wall and the rest of the tire is not defined, therefore one of ordinary skill in the art would not know which part of the tire is required by the claim to be less rigid than the flange seat, and b) one of ordinary skill in the art would not know the meaning of the term “rigid” in the context of the entire flange seat being more rigid than another part of the tire:

applicants recite in the specification paragraph 0051 that “the rigidity of the flange seat 109 may be increased by any number of methods known in the art such as, for example, including or modifying the characteristics of imbedded radial belts, heating and/or compressing the rubber material, or otherwise changing the density or composition of the rubber material of the tire wall in this region”, however all of these techniques involve components of the flange seat rather than the flange seat as a whole. For example, the most rigid parts of pneumatic tires are conventionally the beads, which include a rigid bead core in order to secure the tire on the rim during service; since the claimed

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flange seat includes the outboard bead, providing a conventional bead core in the outboard bead would normally render *a component* of the flange seat “substantially more rigid” than *any component in* the remainder of the outboard tire wall but would not be sufficient to render the flange seat as a whole “substantially more rigid than the remainder of the outboard tire wall”.

To eliminate the new matter noted in paragraph 8 above applicants should cancel claim 34.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 31-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Casanova et al. (4,856,572) or, alternatively, Suzuki (4,319,618).

See Casanova et al. embodiment of Figure 1: the flange seat of each tire wall extends from the inner tire diameter (axis Z-Z') to the height (width)  $H_e$  (axis X-X') just below the axially outwardly extending protective rib; the height of the tire walls  $H=585$  mm (23 inches) and the flange seat height (width)  $H_e$  is clearly depicted as a little less than half of  $H$ , so the flange seat height (width)  $H_e$  is a little less than 292 mm (11.5 inches) which clearly meets the claimed at least about 1-1/2 inches; the bead of each tire wall extends from the inner tire diameter (axis Z-Z') to the height (width) of the point F on the surface of the tire wall, which is clearly depicted as less than half the height (width)  $H_e$  of the flange seat, so the portion of the flange seat height (width)  $H_e$  extending beyond the bead height (width) is greater than half of  $H_e$ =a little less than 292 mm (11.5 inches) or greater than a little less than 146 mm (5.7 inches) which clearly meets the claimed at least about 1/2 inches. As to claim 33, see paragraph 9 above: to the extent that this limitation can be understood, it



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appears that the presence of the bead core 3 and the carcass upturned portion 11 in the flange seat of each tire wall render the flange seat "substantially more rigid" than the remainder of the tire wall. As to claims 38 and 42, a little less than half meets the claimed "at least about one-half".

Alternatively, see Suzuki embodiment of Figure 1: the flange seat of each tire wall extends from the inner tire diameter (axis a-a) to the height (width) of  $H-D=413\text{ mm} - 180\text{ mm} = 233\text{ mm}$  (9.2 inches); the bead height (width) is clearly depicted as around a quarter of the flange seat height (width), so the portion of the flange seat height (width) extending beyond the bead height (width) is around 175 mm (6.9 inches). As to claim 33, see paragraph 9 above: to the extent that this limitation can be understood, it appears that the presence of the bead cores 11 in the flange seat of each tire wall render the flange seat "substantially more rigid" than the remainder of the tire wall. As to claims 36-38 and 40-42, the height (width) of the tire wall is clearly depicted as a little less than  $H=413\text{ mm}$ , so the flange seat height (width) is a little more than  $233\text{ mm}/413\text{ mm} = 56\%$  of the height (width) of the tire wall.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references anticipate or render obvious at least claim 31 but are considered to be no more pertinent to the instant claims than the prior art already applied by the examiner: Butler (796,894); Gottschall (2,572,259); Olagnier et al. (3,204,681); Matsuyama et al. (3,825,052); Soma et al. (4,120,337); Yeager et al. (4,356,985); Shurman (4,809,757); Demor, III et al. (4,926,918); Naoi (5,871,599); Sakamoto et al. (6,418,993 B1); Japanese Patent Applications 55-91409 A, 59-179407 A, and 3-228903 A; and Swiss Patent 393117.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571)272-1218. The examiner can normally be reached on Monday-Friday, 10:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571)272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adrienne Johnstone

June 14, 2005

Adrienne C. Johnstone  
Primary Examiner  
Art Unit 1733

A handwritten signature in black ink that reads "Adrienne C. Johnstone". The signature is written in a cursive, flowing style with a large, sweeping initial 'A'.